

REMARKS

1 The Examiner objected to claims 1-9, requesting clarification as to whether
applicant is claiming the sub-combination of the bracket or the combination of the
bracket, the existing and new building panels, the frame and the fasteners. Applicant is
5 claiming only the bracket. Claims 6 and 7 have been cancelled and claims 1, 3-5 and 8
have been amended to more clearly relate the limitations as against the bracket only
and referring to the others structures in a generic sense. Applicant now believes the
claims to be in condition for allowance.

10 The Examiner rejected claims 1-4 and 6-9 under 35 U.S.C. § 102(b) as being
anticipated by U.S. Patent No. 5,845,446 to Funaki et al. The applicant respectfully
disagrees with each of the aforementioned rejections. However, in an effort to expedite
the prosecution of the present application, applicant has amended claim 1 to more
clearly describe the present invention. Specifically, the applicant has amended claim 1
15 with the limitation that:

 said forward and rearward wall members being shaped and sized to marry
the profile of the alternating peaks and valleys along the outwardly facing
surface of the existing building panel when said brace is positioned closely
adjacent, and generally perpendicular to, the alternating peaks and valleys
of the existing building panel . . .

20 This structural configuration of the bracket is quite specific and detailed in a manner not
found within the prior art. The Funaki, et al. reference does not teach or otherwise
contemplate a bracket having this structural configuration. Accordingly, claim 1 is
believed to be patentable.

1 Claims 2-5, 8 and 9 each ultimately depend from claim 1 and are believed to be
allowable for at least the reasons set forth herein with respect to claim 1. Moreover,
Funaki, et al. does not teach that the bracket is comprised of a substantially insulative
material. Rather, the reference teaches that the bracket may be formed from aluminum
or extruded resin; neither of which are noted as being insulative. To be sure, aluminum
5 is conductive.

Claim 5 has been amended to more clearly state that bracket channel is "shaped
and sized to substantially enclose and engage the at least one existing fastener in a
manner that substantially prevents said bracket from moving in a generally parallel
10 fashion with respect to the at least one existing building panel." Nowhere in the prior art
is there a bracket of the same claimed structural configuration that is capable of
engagement with existing fasteners in this manner.

Claim 8 has been amended to more clearly state that, "the lower end portions of
said forward and rearward wall portions are shaped so that a substantial portion of the
15 lower end portions of said forward and rearward wall portions engage the outwardly
facing surface of the at least one existing building panel." Again, this is a specific
structural configuration not found within the prior art bracketry and provides dramatically
increased stability due to this unique configuration.

20 The Examiner has initially rejected claim 5 under 35 U.S.C. § 103(a) as being
obvious over the Funaki et al. patent. Specifically, the Examiner states that the Funaki
et al. patent discloses the structure as set forth within claim 5 except for the detail that
the bracket is sized and shape to prevent parallel movement with respect to the building

1 panel. The Examiner states that it would have been obvious to one having ordinary skill
in the art at the time the invention was made that the Funaki et al. bracket prevents this
type of movement. The applicant disagrees. The claimed combination of structural
elements within claim 5 cannot be summarily dismissed as being obvious in view of the
prior art without some objective teaching, suggestion or motivation within the prior art
5 that solves a problem in the art in the manner claimed by the applicant. Claim 5 has
been amended as set forth hereinabove.

Obviousness can only be established by combining or modifying the teachings of
the prior art to produce a claimed invention where there is some teaching, suggestion,
10 or motivation to do so, found either explicitly or implicitly in the references themselves or
in the knowledge generally available to one of ordinary skill in the art. "The test for an
implicit showing is what the combined teachings, common knowledge of one of ordinary
skill in the art, and the nature of the problem to be solved as a whole would have
suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 55
15 USQP2d 1313 (Fed. Cir. 2000). In the Kotzab case, the Federal Circuit decided that the
control of multiple valves by a single sensor, rather than by multiple sensors, was a
simple concept. However, the Federal Circuit held that there was no finding as to the
specific understanding or principle within the knowledge of the skilled artisan that
20 would have provided the motivation to use a single sensor as the system to control
more than one valve. Id. Without the necessary teachings, motivations or suggestions
from the cited prior art, claim 5 is believed to be allowable over the cited prior art.

1 The Examiner claims 10-13 under 35 U.S.C. § 103(a) as being obvious over the
Funaki et al. patent in further view of U.S. Patent No. 5,511,354 to Eidson. Again, the
Examiner states that the Funaki et al. patent discloses each of the structural limitations
found within these claims, except for discrete structural details that are argued to be
taught or otherwise suggested within the Eidson patent. Applicant respectfully
5 disagrees. First, Funaki et al. teach a bracket that cannot be used for repaneling or
reroofing a structure. A person of ordinary skill in the art looking to create a new
bracket for such a use, that provides increased stability and usability would not, on any
objective basis look to the teachings of Funaki, et al. Moreover, the applicant has
10 amended claims 10 to more clearly claim the structural configuration of the bracket, as
described hereinabove with respect to claim 1, rendering the teachings of Funaki, et al.
inapplicable to the present method claims.

15 The mere fact that the references can be modified does not render the resulting
modified structure obvious unless the prior art also suggests the desirability of the
combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). "A
statement that modifications of the prior art meet the claimed invention and would have
been 'well within the ordinary skill in the art at the time the claimed invention was made
because the references relied upon teach that all aspects of the claimed invention were
20 individually known in the art' is not sufficient to establish a *prima facie* case of
obviousness without some objective reason to combine the teachings of the
references." Ex parte Leavengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).
The combined teachings of the cited references do not provide a sufficient body of

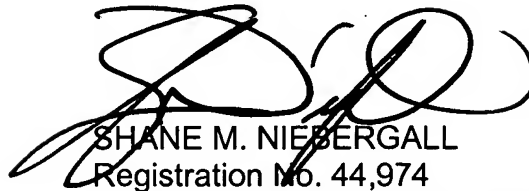
1 material to render claim 10 obvious to a person of ordinary skill in the art, even in view
of the presumed knowledge held by such a person of skill in the art.

5 In determining the difference between the prior art and the claims, the question
under 35 U.S.C. § 103 is not whether the differences themselves would have been
obvious, but whether the claimed invention as a whole would have been obvious.
Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). A
prior art reference and the claimed invention must be considered in their entirety.
Distilling an invention down the "gist" or "thrust" of an invention disregards the
requirement of analyzing the subject matter "as a whole." W.L. Gore & Associates, Inc.
10 v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *Cert. denied*, 469 U.S.
851 (1984). Claim 10 is patentably distinct in view of the prior art. Claims 11, 12 and
14-18 each ultimately depend from claim 10 and are believed to be allowable for at least
the reasons set forth herein with respect to claim 10. Moreover, each of these
15 dependent claims are comprised of structural and procedural limitations similar to those
discussed with respect to claims 1-5, 8 and 9, and are believed to also be patentably
distinct in view of these structural and procedural limitations.

20 In light of the above amendments and remarks, applicant asserts that each of the
currently pending claims is believed to be patentable over the cited prior art.
Accordingly, applicant respectfully requests reconsideration and allowance of the same.

25 No fees or extensions of time are believed to be due in connection with this
amendment; however, please consider this a request for any extension inadvertently
omitted, and charge any additional fees to Deposit Account No. 502093.

Respectfully submitted,

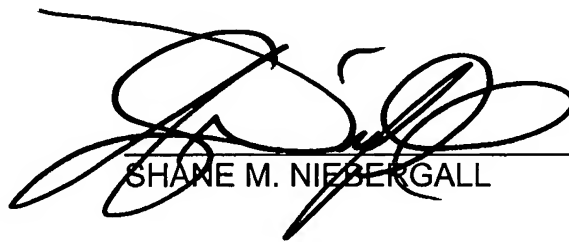


SHANE M. NIEBERGALL
Registration No. 44,974
THOMTE, MAZOUR & NIEBERGALL
Attorneys of Record

2120 S. 72nd Street, Suite 1111
Omaha, NE 68124
(402) 392-2280

CERTIFICATE OF MAILING

I hereby certify that the original of this AMENDMENT for ARNOLD G. LEGBAND, Serial No. 10/667,000, was mailed by first class mail, postage prepaid, to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 19th day of September, 2005.



SHANE M. NIEBERGALL